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In re Application of SHEMI et al.

Application No.: 10/590,053

PCT No.: PCT/IL05/00208

Int. Filing: 20 February 2005

Priority Date: 04 February 2004

Attorney Docket No.: P-6624-US

For: SYSTEM AND METHOD FOR THE
FABRICATION OF AN ELECTRO-OPTICAL
MODULE

:
: DECISION ON PETITION

:
: UNDER 37 CFR §§1.47(a) and 1.137(b)

This is a decision on applicant's petition under 37 CFR §§1.137(b) and 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 20 December 2007, to accept the application without the signature of joint inventor Dr. Amotz Shemi.

BACKGROUND

On 21 August 2006, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 20 November 2006, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required. The application went abandoned on 20 June 2007 for failure to reply to the 20 November 2006 Notification of Missing Requirements within the time period set therein. A Notification of Abandonment was not mailed to applicant.

On 20 December 2007, applicant filed the instant petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor Shemi and a revocation of power of attorney with new appointment. The petition under 37 CFR 1.47(a), in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), requested the acceptance of the application without the signature of inventor Shemi, alleging that Dr. Shemi refused to sign the application.

DISCUSSION

Petition under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper response unless it has been previously submitted, (2) the fee required by law for revival of an unintentionally abandoned application (1.17(m)), and (3) a statement that the "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional".

With regard to Item (1), a review of the application file reveals that the proper reply, a declaration executed by the inventors, in compliance with 37 CFR 1.497(a) and (b), was not provided. Instead, Petitioner filed a petition under 37 CFR 1.47(a) with respect to the non-signing inventor, which is addressed below.

With respect to Item (2), the required petition fee of \$770 has been paid.

With respect to Item (3), applicant's statement that "the entire delay in filing the required reply in response to the Notification from the due date for the reply until the filing of the present, grantable petition under 37 CFR 1.137(b) was unintentional" does not meet the requirements of 37 CFR 1.137(b)(3). The present counsel of record indicates that "as a consequence of the engagement of new attorneys, as indicated by Attachment (3) and the physical transfer of the application file, the need to respond to the Notification was overlooked." This explains the delay for the period of time when present counsel took over application file until the filing of the petition (approximately 30 August 2007 until 20 December 2007). However, no explanation is given for the delay in filing a reply to avoid abandonment of the application (20 June 2007). What is required is a statement by counsel of record at the time of abandonment (20 June 2007) indicating whether the delay was unintentional.¹

Petition under 37 CFR 1.47(a)

¹ MPEP section 711.03(c)II.C.2.E. states as follows: The question under 37 CFR 1.137 is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unavoidable or unintentional. When the applicant assigns the entire right, title, and interest in an invention to a third party (and thus does not retain any legal or equitable interest in the invention), the applicant's delay is irrelevant in evaluating whether the delay was unavoidable or even unintentional. See *Kim v. Quigg*, 718 F. Supp. 1280, 1284, 12 USPQ2d 1604, 1607-08 (E.D. Va. 1989). When an applicant assigns the application to a third party (e.g., the inventor/applicant's employer), and the third party decides not to file a reply to avoid abandonment, the applicant's actions, inactions or intentions are irrelevant under 37 CFR 1.137, unless the third party has reassigned the application to the applicant prior to the due date for the reply. *Id.*

Likewise, where the applicant permits a third party (whether a partial assignee, licensee, or other party) to control the prosecution of an application, the third party's decision whether or not to file a reply to avoid abandonment is binding on the applicant. See *Winkler*, 221 F. Supp. at 552, 138 USPQ at 667. Where an applicant enters an agreement with a third party for the third party to take control of the prosecution of an application, the applicant will be considered to have given the third party the right and authority to prosecute the application to avoid abandonment (or not prosecute), unless, by the express terms of the contract between applicant and the third party, the third party is conducting the prosecution of the application for the applicant solely in a fiduciary capacity. See *Futures Technology Ltd. v. Quigg*, 684 F. Supp. 430, 431, 7 USPQ2d 1588, 1589 (E.D. Va. 1988). Otherwise, the applicant will be considered to have given the third party unbridled discretion to prosecute (or not prosecute) the application to avoid abandonment, and will be bound by the actions or inactions of such third party. (Emphasis added.)

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

The petition included the requisite petition fee, satisfying Item (1). Item (3) is satisfied because the last known address of non-signing inventor Amotz Shemi was provided.

With regard to item (4), the declaration executed by the available joint inventors on their behalf and on behalf of the non-signing inventor was submitted and is found to be defective. The declaration is a three page declaration; however, the declaration as filed is comprised of four pages: one page "1", one page "2" and two pages marked "3", which are executed by different inventors. The declaration appears to be a composite declaration created from the combination of separately executed declarations. The declaration is not properly executed. It appears that either the attorney pieced together separate complete declarations into one composite declaration or that the inventors were presented with an incomplete declaration. While it is acceptable for applicants to execute separate copies of the declaration, the entire declaration, as executed by the inventor, must be submitted. "Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration." See MPEP 201.03. The declaration is unacceptable as filed. Item (4) is not satisfied.

Inventor's Refusal to Sign

With respect to Item (2) above, the declaration by Shai Belzer, Chief Financial Officer of ColorChip, Ltd. was attached to the petition, detailing the efforts made to obtain the nonsigning inventor's signature. According to his declaration, on 30 August 2007, Mr. Belzer sent, via registered mail, a package containing several documents including a declaration to Dr. Shemi's last known address. On 25 September 2007, Dr. Shemi called Mr. Belzer and told him that he had received the documents and verbally refused to sign the declaration. The nonsigning inventor must be presented with a copy of the application papers before a petition under 37 CFR 1.47 can be granted in order to apprise the inventor of the application to which the declaration is directed. Neither Mr. Belzer's letter or his declaration indicate that a complete copy of the application papers (including specification, claims, drawings, and oath or declaration) were sent to the nonsigning inventor for his signature.

See Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal.²

² A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

In sum, Petitioner has satisfied Items (1) and (3).


Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/590,053 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and Dr. Shemi's refusal to sign, either in writing or by telephone, these documents. Item (4) is not satisfied as the declaration is unacceptable as filed. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petitions under 37 CFR §§1.47(a) and 1.137(b) are **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petitions under 37 CFR §1.47(a) and 1.137(b) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a) and 1.137(b)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.
(Emphasis added.)